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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,153	03/30/2004	Jean-Pierre Leblanc	2022D.PC	5423

7590

05/23/2005

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT PAPER NUMBER

1615

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,153

Applicant(s)

LEBLANC ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20 and 22-30 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment file don 1/24/05. Claims 17-30 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 29-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to skin care compositions comprising solubilized anionic polyurethane and at least one solvent and further comprising therapeutic additive (claim 29) or the additive is selected from the group consisting of additives used to treat dermatitis hypetiformis, warts, uticaria, hives, scars, keloids, scleroderma, lupus erythematosus, hirsutism, acne, pimples, athlete's foot, and herpes (claim 30). There is no description in the specification to the compounds used to treat the various disorders. There is neither description in each category nor exemplification.

Claims drawn to skin care compositions, employing this language at the point of novelty, such as applicants', neither provide those elements required to practice the inventions, nor "inform the public" during the life of the patent of the limits of the monopoly asserted. The expression could encompass myriad of compounds and applicants claimed expression represents **only an invitation to experiment regarding possible compounds.**

Response to Arguments

3. Applicant's arguments filed 1/24/05 have been fully considered but they are not persuasive.

4. Applicants argue that the section 112, enablement requirement implicitly tolerates a disclosure requiring experimentation to make or use the claimed invention so long as the experimentation is not undue or unreasonable and point out that the present description states that skin care compositions according to the invention includes without limitation sunscreen and suntan compositions, after-sun compositions, hand and body moisturizers, face creams and lotions, skin tightening and firming compositions, and cleansing compositions, color cosmetics, and whitening compositions (Specification: p. 4, lines 13-19) and therefore one skilled in the art would understand this term to include those additives which have therapeutic effects and accordingly the present specification does indeed enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with claims 29-30 including how to make such compounds, what reactants would be employed and processes for preparing those compounds.

In response to the above argument it is the examiners position that the claims are rejected for written description and not for scope of enablement (emphasis added). The specification lists

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on page 5 the additives that are used for various diseases and directs one skilled in the art to look into Modern Pharmaceuticals for the description of the diseases and figure out the additives that are used for these conditions. It is the examiners position that claims employing this language at the point of novelty, such as applicants', neither provides those elements required to practice the inventions, nor "inform the public" during the life of the patent of the limits of the monopoly, asserted. The expression could encompass myriad of compounds and applicants claimed expression represents **only an invitation to experiment regarding possible compounds included for therapeutic additives.**

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 16-20, and 22-28 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 6,264,933 ('933).

CLAIM CONSTRUCTION

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The specification does not define the meaning for “treating skin”. The specification various examples drawn to cosmetic compositions and based upon the disclosure it is the examiners position that “treating skin” is equivalent to cosmetic compositions applied to skin.

See the abstract for “costing the keratin fibers” which reads on the claimed method and color cosmetics of claim 22. See claim 11 for “anionic polyurethane” claimed in the instant application, see also col.4, lines 5-15 for the ranges, see col.4, line 48 for “polyacrylates and polymethacrylates” which is the claimed second solubilized polymer. See also the ranges at lines 29-30. The lower range reads on the claims 23-25 and the claimed ranges of both the polymers are within the claimed ranges for claims 26-28.

Response to Arguments

7. Applicant's arguments filed 1/24/05 have been fully considered but they are not persuasive.

Applicant's argue that patent '933 teaches a cosmetic composition for keratin fibers (mascara for eyelashes) formed from at least one lamellar filler and an aqueous phase dispersed in a liquid fatty phase containing at least one volatile organic solvent and the aqueous phase contains a polymer system comprising at least one film-forming polymer dispersed in the aqueous, phase in the form of solid particles (abstract; col. 1, lines 55- 63; col. 2, lines 18-21 where as, the present invention is directed towards a method for treating skin involving applying to the skin a skin care composition formed from at least solubilized anionic polyurethanes and at least one solvent and therefore patent '933 does not teach or suggest solubilized polyurethanes claimed in the instant application.

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In response to the above argument, the specification at page 4, defines solubilized polyurethane as

“The polyurethane or polyurethane mixture is solubilized in a suitable solvent using techniques known in the art. Such solvents include without limitation alcohols such as methanol, ethanol, propanol, ethers, esters such as ethyl acetate and propyl acetate, diols such as ethylene glycol, polyols such as glycerol and sorbitol, amides, carbamates, sugars, substituted ethers such as dipropylene glycol dibutyl ether, and non protic polar solvents such as N-methyl pyrrolidone.”

The claims are drawn to solubilized polyurethane and organic solvent. The specification does not define the scope of “ organic solvent” in addition to the solvents used for solubilized polyurethane. If applicants disagree with the examiner they are requested to point out support for the definition of “ organic solvents” excluding the solvents mentioned supra for solubilizing polyurethane. The patent claims one anionic polyurethane and also organic solvent. Therefore the patent anticipates the claims. The use of the term “ comprising” permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. Moleculon Research corp., v. CBS, Inc., 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In re Baxter, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981).

Allowable Subject Matter

8. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

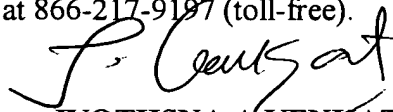
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JYOTHSNA A. VENKAT Ph. D** whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **THURMAN K. PAGE** can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
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